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EXAMINER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

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8 *Ex parte* ANDREW C. NEFF  
9

10  
11 Appeal 2008-004989  
12 Application 09/534,836  
13 Technology Center 3600  
14

15  
16 Decided:<sup>1</sup> July 6, 2009  
17

18  
19 *Before:* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and  
20 JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

21  
22 CRAWFORD, *Administrative Patent Judge.*  
23

24  
25 DECISION ON APPEAL  
26

27 STATEMENT OF THE CASE

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<sup>1</sup>The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1 to 34. Claims 35 to 40 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented a method, article, and apparatus for registering registrants such as voter registrants (Specification 1).

Claim 1 under appeal reads as follows:

1. A method of registration, comprising:  
receiving a hash of a public key and a  
written signature of each of a plurality of  
registrants through a first channel of  
communications that includes hand-delivery;  
receiving a public key and associated  
identifying information of at least some of the  
plurality of registrants through a second channel of  
communications, different from the first channel of  
communications that excludes hand-delivery;  
for each of the plurality of registrants,  
digitally signing the public key if the hash of the  
public key of the registrant received through the  
first channel of communications corresponds to the  
public key of the registrant received through the  
second channel of communications; and  
providing the digitally signed public keys to  
an authenticating authority.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Challener	US 6,081,793	Jun. 27, 2000
Mark A. Herschberg, <i>Secure Electronic Voting Over the World Wide Web</i> , Massachusetts Institute of Technology, 4-81 (1997) (hereinafter "Herschberg").		

The Examiner rejected claims 1 to 34 under 35 U.S.C. § 103(a) as being unpatentable over Herschberg in view of Challener.

ISSUES

Has Appellant shown that the Examiner erred in rejecting the claims because Herschberg and Challenger do not disclose voter registration?

Has the Appellant shown that the Examiner erred in rejecting claims 21 to 28 because neither Herschberg nor Challenger disclose or suggests verifying an identity of the registrant in person or a tangible medium having a written or printed hash of a registrants' public key with a written signature on the tangible medium?

FINDINGS OF FACT

Appellant discloses that a registrant corresponds to a voter. (Specification 5).

Webster defines a registrant as one that registers or is registered. *Merriam Webster Online Dictionary* (2009) (<http://www.merriam-webster.com/dictionary/registant>).

Herschberg discloses a method of electronic voting that requires that a voter register a name and a password (page 16). Herschberg also discloses the known practices of verifying the identity of a voter using the written signature of the voter and by validating a password (pages 23 to 24; 33).

Challenger discloses issuing a smart card to a voter which includes the voter identification and a public and private key (col. 3, ll. 9 to 15).

Challenger also discloses verifying the identity of the voter by utilizing a public key of the voter (col. 10, ll. 1 to 20). The voter in Challenger has a choice between voting electronically utilizing a distributed data processing system and/or the internet, or he or she may choose to physically show up at the polling place and vote utilizing a paper ballot. (Col. 6, ll. 57-61).

PRINCIPLES OF LAW

An invention is not patentable under 35 U.S.C. § 103 if it is obvious. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007). The facts underlying an obviousness inquiry include: Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). Against this background the obviousness or nonobviousness of the subject matter is determined.

In addressing the findings of fact, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR* 550 at 416. As explained in *KSR*:

If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida and Anderson's-Black Rock* are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

*KSR* at 417.

A prior art reference is analyzed from the vantage point of all that it teaches one of ordinary skill in the art. *In re Lemelson*, 397 F.2d 1006, 1009 (1968) (“The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are

1 concerned. They are part of the literature of the art, relevant for all they  
2 contain”). Furthermore, “[a] person of ordinary skill is also a person of  
3 ordinary creativity, not an automaton.” *KSR* at 421.

4 On appeal, Applicants bear the burden of showing that the Examiner  
5 has not established a legally sufficient basis for combining the teachings of  
6 the prior art. Applicants may sustain its burden by showing that where the  
7 Examiner relies on a combination of disclosures, the Examiner failed to  
8 provide sufficient evidence to show that one having ordinary skill in the art  
9 would have done what Applicants did. *United States v. Adams*, 383 U.S. 39,  
10 52 (1966).

## 11 12 CLAIM CONSTRUCTION

13 The preambles of independent claim 1 recites “[a] method of  
14 registration.” In claim construction, “[w]hether to treat a preamble as a  
15 limitation is a determination ‘resolved only on review of the entire[ ] ...  
16 patent to gain an understanding of what the inventors actually invented and  
17 intended to encompass by the claim.’” *Catalina Marketing Int’l, Inc. v.*  
18 *Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (Citation  
19 omitted). “In general, a preamble limits the invention if it recites essential  
20 structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to  
21 the claim. *Id.* (Citation omitted). “Conversely, a preamble is not limiting  
22 ‘where a patentee defines a structurally complete invention in the claim body  
23 and uses the preamble only to state a purpose or intended use for the  
24 invention.’” *Id.* (Citation omitted).

25 Claim 1 recites “[a] method of registration” in the preamble of the  
26 claim but does not recite registration in the body of the claim. Rather, the

1 body of the claim recites the receipt of public and private keys from a  
2 plurality of registrants. The term “registrant” is not limited to a person who  
3 is seeking to be registered but rather is broad enough to include someone  
4 who is registered. Based on the review of the entire application on appeal,  
5 we conclude that recitations in the body of the claim define a complete  
6 invention. Furthermore, the recitation of “[a] method of registration” in the  
7 preamble of claim 1 is language of intended use and does not give life,  
8 meaning, and vitality to the claim.

9  
10 ANALYSIS

11 We are not persuaded of error on the part of the Examiner by  
12 Appellant’s argument that the Examiner erred in rejecting the claims  
13 because Herschberg and Challener do not disclose voter registration or the  
14 use of two different channels for a voter registration process. As we stated  
15 above, the recitation in claim 1 of “[a] method of registration” is intended  
16 use language that does not patentably distinguish the claim and the term  
17 “registrant” is a broad term that even by Appellant’s own Specification can  
18 include voters. As such the method of claim 1 is not limited to the act of  
19 registering but rather is broad enough to include any method such as voting  
20 where private and private keys are received from a registrant.

21 We are also not persuaded of error on the part of the Examiner by  
22 Appellant’s argument that neither Herschberg nor Challener discloses two  
23 different channels of communication for use in a registration process. As  
24 stated above, claim 1 is not limited to a registration process. In addition,  
25 Challener discloses two modes of communication because Challener

1 discloses that the voter in Challenger has a choice between voting  
2 electronically utilizing a distributed data processing system and/or the  
3 internet or voting in person.

4 In view of the foregoing, we will sustain the rejection as it is directed  
5 to claim 1. We will also sustain the rejection as it is directed to claims 2 to  
6 20 because these claims stand or fall with claim 1 (Brief 16).

7 We are not persuaded of error on the part of the Examiner by  
8 Appellant's argument that the Examiner erred in rejecting claim 21 because  
9 neither Herschberg nor Challenger disclose verifying the identity of a  
10 registrant in person. As we found above, Herschberg discloses using the  
11 signature of a registrant to verify the identity of the registrant and Challenger  
12 discloses that a voter may vote in person. We are also not persuaded of error  
13 by the Examiner by Appellant's argument that neither Herschberg nor  
14 Challenger suggest the use of a registration card or other tangible medium  
15 having a written or printed hash of a registrant's public key. First, this  
16 argument is not commensurate in scope with the recitations in claim 21  
17 because claim 21 does not recite a tangible medium. In addition, the  
18 Appellant is arguing the separate disclosures of Herschberg and Challenger  
19 when the rejection is based on the combined teachings of Herschberg and  
20 Challenger. In this regard, Challenger discloses the use of a tangible ballot or  
21 smart card that is used during voting which has a hash of a public key and  
22 Herschberg discloses the use of a written signature to identify the voter.

23 As such we will sustain the rejection as it is directed to claim 21. We  
24 will also sustain the rejection as it is directed to claims 22 to 34 because  
25 these claims stand or fall with claim 21 (Brief 16).



CONCLUSION OF LAW

On the record before us, Appellant has not shown that the Examiner erred in rejecting claims 1 to 34 under 35 U.S.C. § 103(a) as being unpatentable over Herschberg in view of Challenger.

DECISION

The Examiner's rejection of claims 1 to 34 under 35 U.S.C. § 103(a) is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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